

PATENT
Atty. Dkt. No. WEAT/0384**REMARKS**

This is intended as a full and complete response to the Final Office Action dated March 31, 2006, having a shortened statutory period for response set to expire on June 31, 2006. Claims 1-25 remain pending in the application. Please reconsider the claims pending in the application for reasons discussed below.

Claim Objections

The Examiner objected to claim 20 because this claim recites the limitation "the polished bore receptacle" in lines 2-3. In response, Applicants have amended claim 20 accordingly. Therefore, Applicants respectfully request the objection to the claims be removed.

Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner rejected claims 1 and 18 as being anticipated by *Rytlewski*, 5,704,426. In response, Applicants have amended claims 1 and 18.

As amended, claims 1 and 18 include similar limitations as claims currently pending in the application and therefore no new matter has been added. More specifically, claims 1 and 18 include the limitation of isolating a treated portion of the wellbore from an untreated portion by latching the plug assembly in a profile in the wellbore as the selective treatment assembly is removed from the wellbore. *Rytlewski* does not disclose isolating a treated portion of the wellbore from an untreated portion by latching a plug assembly in a profile as a treatment assembly is removed from the wellbore, whereby "isolating and removing" are done in a single step. In contrast, as admitted by the Examiner, *Rytlewski* discloses a tool having a two step procedure, whereby in the first step the tool isolates a treated portion from an untreated portion and then in the second step the tool is removed from the wellbore.

As the foregoing illustrates, *Rytlewski* fails to teach or disclose all the limitations of claims 1 and 18. This failure precludes *Rytlewski* from anticipating claims 1 and 18. Therefore, Applicants respectfully request the 102(b) rejection of claims 1 and 18 be removed and the allowance of the same. Further, since claims 2-4, 9-11 and 15-17

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depend from claim 1 and claims 19 and 21-24 depend from claim 18, these claims are allowable for at least the same reasons as claims 1 and 18. Additionally, as discussed herein, the combination of *Rytlewski* and *Baker* also fails to disclose all the limitations of claims 1 and 18.

Claim Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 5 and 7 as being obvious over *Rytlewski* '426 in view of *Baker* 4,372,393. Applicants respectfully traverse the rejection. As set forth above, *Rytlewski* fails to teach or disclose all the limitations of claim 1. *Baker* fails to cure the deficiencies of *Rytlewski*. This failure precludes the combination of *Rytlewski* and *Baker* from rendering claims 5 and 7 obvious.

Moreover, the Examiner has failed to provide a motivation to combine the cited references and therefore has not established a *prima facie* case of obviousness. According to MPEP 2143.01, the prior art must suggest the desirability of the claimed invention. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. There is absolutely no teaching or suggestion in either *Rytlewski* or *Baker* to combine the references. Further, according to MPEP 2143.01, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) *Rytlewski, et al.* requires that the sealing assembly be engaged by moving upwardly from downhole. (See *Rytlewski, et al.*, col. 8, lines 28-40) *Baker* discloses a sealing assembly comprising a polished bore receptacle that includes a no-go shoulder "28" that abuts upwardly facing shoulder "18" to prevent continued movement of packoff member "8" down the oil well past casing bore receptacle "6". (See *Baker*, col. 4, lines 64-69) The limitation of restricting the movement of the packoff member down the oil well past casing bore receptacle disclosed in *Baker* makes the receptacle unsuitable for use with the sealing assembly disclosed in *Rytlewski*. because *Rytlewski* requires that the sealing assembly

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be engaged by moving upwardly from downhole. (See *Rytlewski*, col. 8, lines 28-40) As such, the proposed modification of the tool disclosed in *Rytlewski* to have a casing bore receptacle disclosed in *Baker* would render the tool disclosed in *Rytlewski* unsatisfactory for its intended purpose.

As the foregoing illustrates, the combination of *Rytlewski* and *Baker* fails to teach or disclose all the limitations of claims 5 and 7. This failure precludes the combination of *Rytlewski* and *Baker* from rendering claims 5 and 7 obvious. Therefore, Applicants respectfully request the § 103(a) rejection of claims 5 and 7 be removed and the allowance of the same. In addition to the arguments set forth under the 102(b) rejection regarding *Rytlewski*, the foregoing arguments regarding the combination of *Rytlewski* and *Baker* also apply to claims 1 and 18.

The Examiner rejected claim 6 as being obvious over *Rytlewski*, '426 in view of *Baker*, as applied to claim 5 and further in view of *Simpson*, 6,457,532. Applicants respectfully traverse the rejection. As set forth above, the combination of *Rytlewski* and *Baker* fails to render claim 5 obvious. *Simpson* fails to cure the deficiencies of the combination of *Rytlewski* and *Baker*. This failure precludes the combination of *Rytlewski* and *Baker* and *Simpson* from rendering claim 6 obvious. For this reason, Applicants submit that claim 6 is in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection.

The Examiner rejected claim 12 as being obvious over *Rytlewski*, '426 in view of *Tolman*, '184. Applicants respectfully traverse the rejection. As set forth above, *Rytlewski* fails to fails to teach or disclose all the limitations of claim 1. *Tolman* fails to cure the deficiencies of *Rytlewski*. This failure precludes the combination of *Rytlewski* and *Tolman* from rendering claim 12 obvious. For this reason, Applicants submit that claim 12 is in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection.

The Examiner rejected claims 13-14 as being obvious over *Rytlewski*, '426 in view of *Rosenthal*, 3,642,064. As set forth above, *Rytlewski* fails to fails to teach or

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disclose all the limitations of claim 1. *Rosenthal* fails to cure the deficiencies of *Rytlewski*. This failure precludes the combination of *Rytlewski* and *Rosenthal* from rendering claims 13-14 obvious. For this reason, Applicants submit that claims 13-14 are in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection.

The Examiner rejected claim 20 as being obvious over *Rytlewski*, '426, in view of *Baker*, 4,372,393 and further in view of *Simpson*, '532. Applicants respectfully traverse the rejection. As set forth above, the combination of *Rytlewski* and *Baker* fails to render claim 18 obvious. *Simpson* fails to cure the deficiencies of the combination of *Rytlewski* and *Baker*. This failure precludes the combination of *Rytlewski* and *Baker* and *Simpson* from rendering claim 20 obvious. For this reason, Applicants submit that claim 20 is in condition for allowance and respectfully requests withdrawal of the § 103(a) rejection.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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